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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,321	03/05/2001	Muralidhara Padigaru	15966-703 (Cura-203)	2997

7590

05/06/2002

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EXAMINER

YU, MISOOK

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 05/06/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/800,321

Applicant(s)

PADIGARU ET AL.

Examiner

Misook Yu

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 March 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- |                |   |
|----------------|---|
| Groups 1-15.   | Claims 1-4, 36, and 39, protein and pharmaceutical composition drawn to SEQ ID NO:2, 4, 6 8, 10, 12, 14, 16, 18, 21, 23, 25, 27, 29, and 31, classified in class 530, subclass 350.   |
| Groups 16-30.  | Claims 5-14, 37, and 40, DNA, vector, recombinant cell, pharmaceutical composition drawn to SEQ ID NO:1, 3, 7, 9, 11, 13, 15, 17 and 19 ( <b><i>SEQ ID NO:17 and 19 belong to one group, group 23 because they encode the same protein of SEQ ID NO: 18</i></b> ), 20, 22, 24,26, 28, 30, classified in class 536, subclass 23.1. |
| Groups 31-45.  | Claims 15-17, 38, and 41, antibody and pharmaceutical composition drawn to the 15 different proteins of groups 1-15 above, classified in class 530, subclass 387.1.   |
| Groups 46-60.  | Claims 18, 42, and 43, drawn to method to detect the proteins of groups 1-15, classified in class 436, subclass 501.  |
| Groups 61-75.  | Claims 19-21, 44, and 45, drawn to method to detect DNA of groups 16-30, classified in class 436, subclass 503.   |
| Groups 76-90.  | Claims 22, 23, and 48, drawn to method to identify binding agents to the proteins of groups 1-15, classified in class 435, subclass 4.  |
| Groups 91-105. | Claims 24 and 25, drawn to method to identify proteins' (groups 1-15) activity or expression modulating agents, classified in class 435, subclass 3.  |

- Groups 106-120. Claims 26-28, and 46 drawn to method of treatment or prevention by administration of the proteins of groups 1-15, classified in class 514, subclass 2.
- Groups 121-135. Claims 29-31, drawn to method of treatment or prevention by administration of the DNAs of groups 16-30, classified in class 514, subclass 44.
- Groups 136-150. Claims 32-35, and 47, drawn to method of treatment or prevention by administration of the antibodies of groups 31-45, classified in class 424, subclass 130.1.
- Groups 151-175. Claims 49 and 50, drawn to method to detect receptor-ligand binding by detecting response to the binding, classified in class 435, subclass 4.

The inventions are distinct, each from the other because of the following reasons:

The group 1-15, the group 16-30, and the group 31-45 are structurally and functionally distinct inventions. The groups 1-15 are drawn to structurally different proteins with different biological functions, the groups 16-30 are drawn to nucleic acids encoding the different proteins, and groups 31-45 are drawn to antibodies recognizing the different proteins of the groups 1-15.

Inventions of the groups 1-15 and inventions of the groups 46-60, the groups 76-90, groups 106-120, groups 151-175 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the inventions of groups 46-60, groups 76-90, groups 106-120, and groups 151-175 are materially different processes of using product groups of 1-15.

Invention groups 16-30 and inventions of groups 61-75, groups 121-135 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as

claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case groups 61-75 and groups of groups 121-135 are materially different processes of using product groups of 16-30.

Invention groups 31-45 and groups 136-150, groups 46-60 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case groups 136-150 and groups 46-60 are materially different processes of using product groups of 31-45.

These inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification. The search required for each of the above inventions is not coextensive with regard to the literature and the sequence searches. Further, a reference which would anticipate the invention of any one group would not necessarily anticipate or make obvious the any of the other groups. For these reasons, restriction for examination purposes is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Misook Yu whose telephone number is 703-308-2454. The examiner can normally be reached on 8 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Misook Yu, Patent Examiner  
May 2, 2002

  
**MARY E. MOSHER  
PRIMARY EXAMINER  
GROUP 1800**

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